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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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TOWNSEND AND TOWNSEND AND CREW  
TWO EMBARCADERO CENTER  
EIGHTH FLOOR  
SAN FRANCISCO CA 94111-3834

EXAMINER

ELISCA P

ART UNIT

PAPER NUMBER

2161

DATE MAILED:

08/14/01

4

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

*[Handwritten signature]*

# Office Action Summary

Application No.  
09/475,959

Applicant(s)  
Steven Karl, Schoch et al.

Examiner  
Pierre E. Elisca

Group Art Unit  
2161



☒ Responsive to communication(s) filed on Dec 30, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-9 is/are pending in the application.

Of the above, claim(s) none is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-9 is/are rejected.

☒ Claim(s) 7 and 9 is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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**Examiner Pierre Eddy Elisca**

**United States Department of Commerce**

**Patent and Trademark Office**

**Washington, D. C. 20231**

#### **DETAILED ACTION**

1. This office action is in response to application number 09/457,959, filed on 12/30/1999.
2. Claims 1-9 are presented for examination.

#### ***Claim Objections***

3. Claim 9 is objected to because of the following informalities: claim 9, line 2, "the vendor" should be changed to "a vendor". Claim 9 is also objected to because of the following informalities: Claim 9 recites a system claim that depends upon a method claim, however a system claim should not depend upon a method claim. In order to overcome the objection, Examiner hereby suggests to the Applicant that to amend claim 9 as follow: " A method as in claim 8 wherein the validation number further includes a unique number not controlled by the vendor". Appropriate correction is required.

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***Drawings***

4. The drawings of the specification is objected to because of the following informalities: Color drawings are not acceptable until petition is granted see., 37 CFR 1.84 Standards for drawings.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 7 recites the limitation "the transaction", line 2. There is insufficient antecedent basis for this limitation in the claim. For examination purposes, the Examiner has considered the limitation "the transaction" to be "a transaction".

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 2, 6, 8 and 9 are rejected under 35 U.S.C. 102 (b) as being anticipated by Brandt et al. (U.S. Pat. No. 5,758,068).

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As per claim 1, Brandt discloses a method/apparatus for software license management, which is seen to read on claim 1, wherein said a method for controlling reproduction of software by an end-user of the software, the method comprising:

providing to an entity that licenses its software to users, license generation software (or license manager), which when operated generates validation numbers, there being an unique validation number for each copy (or copy or access) of the software to be separately licensed ( this limitation is disclosed by Brandt in fig 2, abstract, lines 1-16, col 4, lines 66 and 67, col 5, lines 1-4, lines 14-16, specifically wherein said a license key is used for accessing a licenced product on an enterprise computer system. A unique identification (ID) number is assigned to the enterprise. The ID may be any number mutually agreed to by the software vendor and the enterprise owner. Next, for each licenced program covered by an enterprise licensing agreement, a key is issued that ties that particular licensed program to that enterprise's ID, and also the word copy is the process of allowing the licensed program to be accessed);

a copy of the validation number being provided each of a license registration database and included with the software when supplied from the entity (this limitation is disclosed by Brandt in col 1, lines 20 and 22, specifically wherein said a key is created, then distributed, then installed, for each licensed software product on each system and the key was based on a unique system serial number and each was based on the enterprise ID, col 5, lines 5-20. Please note that in order to distribute the key, copies of the key had to be created before distribution, and therefore, it

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is inherent to realize that the software licenses provided a copy of the key with the software to the entity);

when the user install a software on a designated system, determining a registration key (enterprise key) formed from the unique validation number and additional information from the least one of a related to the designated system and a user password created by the user (this limitation is disclosed by Brandt in col 5, lines 1-4, and lines 21-29, specifically wherein said in order to direct the license manager in each system to accept enterprise ID-based keys, a Software License Enterprise Enabler Program (SLEEP) is provided. The SLEEP itself is key protected and will only run in the presence of a sleep key that ties it to a particular system. When SLEEP runs on that system, it creates an Enterprise Key based on the serial number of the system it runs on and on the enterprise ID. Please note that the unique validation number is seen to read as enterprise (ID) and the number related to the designated system is seen to read as the serial number of the system, and the user password is disclosed in col 6, lines 64-67, col 7, lines 1-4, specifically wherein said the package information describes the product name, ID, options, and other information needed to be able to install, service, and protect the licensed product. The package information is created via commands shown in routine 66. The ADDLicInf command defines basic licensing information such as the vendor password, which is used in validating keys);

in response to the information provided, using the license registration database (or license manager), generating a license key number (this limitation is disclosed by Brandt in the abstract, lines 17-

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20, specifically wherein said the setup of the license key, along with calling the identifier codes, “and remember that the first identifier code includes a serial number that is used for allowing the license key to identify the enterprise” from the enterprise system, each computer, and the license product, is performed by a license manager or license registration database); using the license key number on the users system to unlock use of the software (this limitation is disclosed by Brandt in the abstract, lines 12-16, specifically wherein said a third identifier code is used, which is selected from the licensed product to be used on the enterprise system and is tied to the enterprise system number, thereby allowing the licensed program to be accessed on the enterprise system with only a single key).

As per claim 2, Brandt discloses the claimed method, wherein the registration key (or license key) includes both the user password and the number related to the designated system (this limitation is disclosed by Brandt in col 6, lines 64-67, col 7, lines 1-4, specifically wherein said the package information describes the product name, ID, options, and other information needed to be able to install, service, and protect the licensed product. The package information is created via commands shown in routine 66. The ADDLicInf command defines basic licensing information such as the vendor password, which is used in validating keys, and also in the abstract, lines 6-8, specifically wherein said a first identifier code from the enterprise computer system, such as the serial number, is used for allowing the license key to identify the enterprise).

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As per claim 6, Brandt discloses the claimed method, wherein the unique validation number comprises information identifying the entity, information identifying the product, and information identifying the particular product to which the unique validation number is applied (**this limitation is disclosed by Brandt in col 6, lines 64-65, specifically wherein said the packaging information describes the product, ID or enterprise ID or unique validation number, options, and other information needed to be able to install, service, and protect the licensed product).**

As per claim 8, Brandt, discloses the claimed method comprising the step of also providing the unique validation number to a library containing other such validation numbers (**this limitation is disclosed by Brandt in col 4, lines 51-67, col 5, lines 1-5, specifically wherein said data processing network 8 or enterprise , fig 1 each such data processing procedure or document is associated with a resource Manager or Library Service. Since they are all similarly associated, a unique identification (ID) number and serial number are assigned to the enterprise).**

**Note**

9. For examination purposes the Examiner interprets claim 9 as a method claim.

As per claim 9, Brandt discloses the claimed method, wherein the validation number further includes a unique number not controlled by a vendor (**this limitation is disclosed by Brandt in col**



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5, lines 43-49, please note that a unique number not controlled by a vendor is seen to read as the information encryption key that the customer is using for encrypting data).

*Claim Rejections - 35 USC § 103*

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 3-5 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Brandt et (U.S. Pat. No. 5,758,068).

As per claim 3, Brandt substantially discloses the claimed method as stated in claim 2 above, including a number related to the designated system (see., Brandt in the abstract, lines 6-8, specifically wherein said a first identifier code from the enterprise computer system, such as the serial number, is used for allowing the license key to identify the enterprise). Brandt does not expressly show that the number being related to the designated system comprises a number already stored on the hard disk drive in the user system of how this number is obtained is expressly recited in claim 3.

However the determining of a registration key would be performed the same regardless of the source of these data or numbers. Thus, this description material will not distinguish the claimed invention

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from the prior art in terms of patentability, see in re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F. 3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to obtain this number from any type of sources because such number does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed method.

**As per claim 4, Brandt** substantially discloses the claimed method as stated in claim 2 above, including a number related to the designated system (see., **Brandt in the abstract, lines 6-8, specifically wherein said a first identifier code from the enterprise computer system, such as the serial number, is used for allowing the license key to identify the enterprise**). Brandt does not expressly show the number being related to a number that already stored in a microprocessor in the user system of how this number is obtained is expressly recited in claim 4.

However the determining key of a registration key would be performed the same regardless of the source of this data or number. Thus, this description material will not distinguish the claimed invention from the prior art in terms of patentability, see in re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F. 3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to obtain this number from any type of sources because such number does not functionally

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relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed method.

As per claim 5, **Brandt** substantially discloses the claimed method as stated in claim 2 above, including a number related to the designated system (see., **Brandt in the abstract, lines 6-8, specifically wherein said a first identifier code from the enterprise computer system, such as the serial number, is used for allowing the license key to identify the enterprise**). **Brandt** does not expressly show the number being related to a number derived from a network interface card installed in the user system of how this number is obtained or derived is expressly recited in claim 5.

However the determining of a registration key would be performed the same regardless of the source of these data or numbers. Thus, this description material will not distinguish the claimed invention from the prior art in terms of patentability, see in re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F. 3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to obtain this number from any type of sources because such number does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed method.

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*Allowable Subject Matter*

12. Claim 7 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

**REASONS FOR ALLOWANCE**

13. This is an Examiner's Statement of Reasons for Allowance: the prior art of record (**Brandt et al, U.S. Pat. No. 5,758,068 and Coley et al. U.S. Pat. No. 5,790,664**) do not teach or suggest alone or in combination : at the time the user registers licensing of the software for a particular system, the transaction is carried out on-line, and software determines the number related to the designated system.

Coley ("664) discloses for tracking the use of a software and also for determining whether the software is validly licensed.

Brandt ("068) discloses a license key for accessing a licenced product on an enterprise computer system.

*Conclusion*

14. The prior art made of record and relied upon is considered to applicant's disclosure.

U.S. Pat. No. 5,204,897 Wyman

This paten relates to a method and system for managing the licensing of software executed on computer systems (see., abstract).

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Any inquiry concerning this communication from the examiner should be directed to Pierre Eddy Elisca at (703) 305-3987. The examiner can normally be reached on Monday, Tuesday, and Wednesday from 5:30AM. to 6:00PM.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9769.

**Any response to this action should be mailed to:**

Commissioner of patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 308-9051, (for formal communications intended for entry )

**OR:**

(703) 305-3718 ( for informal or draft communications, pleased label

"PROPOSED" or" DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth floor (receptionist ).

  
Pierre Eddy Elisca

**Patent Examiner**

**August 10, 2001**